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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,730	06/20/2005	Ansgar Behler	C 2680 PCT/US	8621

23657 7590 03/15/2007  
COGNIS CORPORATION  
PATENT DEPARTMENT  
300 BROOKSIDE AVENUE  
AMBLER, PA 19002

EXAMINER
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NAGUBANDI, LALITHA

ART UNIT	PAPER NUMBER
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1621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/15/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/539,730

Applicant(s)

BEHLER ET AL.

Examiner

Lalitha Nagubandi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-54 is/are allowed.
- 6) ☒ Claim(s) 35-43 is/are rejected.
- 7) ☒ Claim(s) 44-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Detailed Office Action***

***Status of the application***

Claims 35-54 are currently pending and claims 1-10 were being cancelled in the preliminary amendment, claims 11-34 are being canceled in the current amendment and Claims 35-54 are being added. Claims 35-54 are considered for examination in this office action.

***Response to Arguments***

Applicants' amendment to claims, filed on December 7<sup>th</sup> 2006, with respect to the previous office action dated September 28<sup>th</sup> 2006, is sufficient to obviate the rejection of record.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

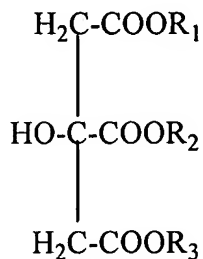
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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gagnebien et al (US Pat. No. 6,024,947 dated Feb. 15, 2000) and Turchini et al (EP 0199131 A2 dated march 25<sup>th</sup>, 1986).

**Determination of Scope and content of the Prior Art (MPEP§2141.01)**

Gagnebien et al teach (see: 2, lines 5-50 and col. 5 lines 20 -25 Formula (I) US Pat. No. 6,024,947 dated Feb. 15, 2000) cosmetic compositions of citric acid esters, R<sub>1</sub> R<sub>2</sub> and R<sub>3</sub> as defined. Further, the use of Mixtures of formula I has been taught.



Formula (I)

Turchini et al teach (see column 1 lines 5-40, EP 0199131 A2) various citric acid compositions.

**Ascertainment of the difference between the Prior Art and Claims (MPEP §2141.02)**

The difference between the instant composition and Gagnebien et al is that the instant cosmetic composition requires 2 to 10 parts ethylene oxide per alkyl group of the ethoxylated alkyl group present in the ester component, which is not exactly taught by Gagnebien.

However, Turchini teaches the esterification process using the ethoxylated alcohols (please see pages 4 – 9, EP 0199131 A2). Further, Turchini teaches the preparation of the ethoxylated alcohols by reacting the alcohol with ethylene oxide using an alkaline base as a catalyst. (See lines 45-50, page 4, EP 0199131 A2).

**Finding of prima facie obviousness – rational and motivation (MPEP § 142-2143)**

Accordingly, one of ordinary skill in the art would be motivated to prepare the instant citric acid compositions by combining the teachings of Gagnebien and Turchini, available at the time to prepare the desired citric acid ester compositions using ethylene oxide.

It would have been obvious to a formulation chemist to arrive at the desired composition from the teachings of Turchini and with necessary modification by altering the weights of the alkylating/ethoxylating agents used during esterification process, an improved cosmetic composition can be obtained.

The examiner contends that the combination of references, would lead to the instant cosmetic composition and one of ordinary skill in the art would be motivated to arrive at the instant composition and would have had a reasonable expectation of success. Hence it is a prima facie.

***Claim Objections***

Claims 44-46 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in an independent form.

***Allowable Subject Matter***

Claims 47- 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalitha Nagubandi whose telephone number is 571 272 7996. The examiner can normally be reached on 6.30am to 3.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571 272 0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lalitha Nagubandi  
Patent Examiner  
Technology Center 1600

March 9<sup>th</sup>, 2006.



Samuel A Barts Ph.D.

Primary Patent Examiner  
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